

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BIG O TIRES, INC.,)	OPPOSITION No:	91163791
)		
Opposer,)	SERIAL No:	78/264,260
)		
v.)		
)		
WHEEL SPECIALTIES, LTD.)		
)		
Applicant.)		

TTAB

APPLICANT'S MOTION TO COMPEL

Applicant, Wheel Specialties, Ltd., through its undersigned counsel, hereby moves for an Order from the Trademark Trial and Appeal Board (the "Board") compelling Opposer, Big O Tires, Inc., to serve amended and/or supplemental responses to Applicant's interrogatories and document requests. In support of this Motion, Applicant states as follows:

I. INTRODUCTION

On July 29, 2005, Applicant served its first set of interrogatories and first request for production of documents on Opposer. Copies of Applicant's First Set of Interrogatories and First Request for Production of Documents are attached hereto as Exhibits A and B, respectively.

Also on July 29, 2005, Applicant produced documents bearing Applicant's Production Nos. WSL 1-249 in response to Opposer's First Request for Production of Documents. A copy of Applicant's counsel's July 29, 2005 letter that accompanied such production is attached hereto as Exhibit C.



02-21-2006

U.S. Patent & TMO/TWI Mail Rpt Dt. #34

On September 9, 2005, Opposer served its responses to Applicant's interrogatories and document requests. Copies of Opposer's Responses to Applicant's First Set of Interrogatories and Opposer's Responses to Applicant's First Request for Production of Documents are attached hereto as Exhibits D and E, respectively.

However, Opposer has yet to produce the documents Opposer promised to produce in its discovery responses, despite repeated requests by Applicant's counsel to do so.

On September 29, 2005, within a few days after Applicant's counsel received a letter dated September 26, 2005 from Opposer's counsel (attached hereto as Exhibit F) raising concerns about Applicant's discovery responses, Applicant's counsel phoned Opposer's counsel and asked him to send Applicant's counsel the Board's standard protective order with any changes Opposer's counsel thought might be appropriate. At the same time, Applicant's counsel told Opposer's counsel Applicant had many of the same issues with respect to Opposer's discovery responses. In fact, Applicant's counsel told Opposer's counsel that virtually none of the information requested by Applicant's discovery was provided. Also Applicant's counsel asked Opposer's counsel when Opposer would provide the documents Opposer promised to produce. See copy of Applicant's counsel's handwritten notes of such telephone conference and typed copy thereof for clarity attached hereto as Exhibits G and G1, respectively.

Opposer's counsel did not send Applicant's counsel the draft protective order until December 5, 2005, more than two months after Opposer's counsel agreed to do so. See Opposer's counsel's letter dated December 5, 2005 attached hereto as Exhibit H.

Applicant's counsel signed and sent the protective order to Opposer's counsel along with a letter dated January 12, 2006 requesting Opposer's counsel to file the protective order with the Board and send Applicant's counsel a fully executed copy with a form of certification attached. In the same letter, Applicant's counsel again requested Opposer's counsel to provide the documents Opposer promised to produce in its discovery responses. A copy of Applicant's counsel's January 12, 2006 letter and signed protective order enclosed therewith are attached hereto as Exhibit I. That was over a month ago, and Opposer's counsel has yet to inform Applicant's counsel that he signed and filed the protective order with the Board. Also Opposer has yet to produce the promised documents.

On January 19, 2006 Applicant's counsel sent Opposer's counsel a letter once again reminding Opposer's counsel that Opposer has yet to produce the promised documents. Also in such letter, a copy of which is attached hereto as Exhibit J, Applicant's counsel specifically identified numerous deficiencies in Opposer's responses to Applicant's interrogatories and document requests, and suggested in the last paragraph of such letter that before either party responds to the other's alleged discovery deficiencies, the parties try to reach an agreement as to the extent to which the parties should supplement their responses so it isn't

one sided. Additionally, Applicant's counsel suggested that Opposer's counsel file a further extension request to give the parties time to resolve these issues.

Opposer's counsel has yet to respond to Applicant's counsel's January 19, 2006 letter and Opposer has yet to produce any of the promised documents. Instead, on January 30, 2006 Opposer filed a Motion to Compel Applicant to serve amended and/or supplemental responses to Opposer's interrogatories, document requests and requests for admissions.

From the foregoing, it appears Opposer is only interested in resolving alleged deficiencies in Applicant's discovery responses, not alleged deficiencies in Opposer's discovery responses, thus necessitating that Applicant file this Motion to Compel discovery from Opposer.

II. RULE 2.120(e) STATEMENT

For the reasons more fully set forth in the Introduction section of this Motion and Applicant's supporting Exhibits, Applicant's counsel states that he has made a good faith effort by telephone and correspondence to resolve with Opposer's counsel the issues presented by this Motion and has been unable to reach agreement.

Accordingly, Applicant respectfully requests that the Board grant Applicant's Motion to Compel Opposer to produce responsive documents and serve amended and/or supplemental responses to the following interrogatories and document requests of Applicant.

III. DEFICIENCIES IN OPPOSER'S DISCOVERY RESPONSES

A. INTERROGATORIES

No. 2: Opposer should produce the promised directory of Big O Stores.

Nos. 4a and 4e:

Opposer should identify which of Opposer's Marks is used on or in association with each product or service offered by Opposer as requested in 4a. Also Opposer should give the inclusive dates during which Opposer has offered or sold each product or service under each of Opposer's Marks as requested in 4e.

No. 4f: Opposer's agreement to produce documents from which Opposer's annual sales figures for a reasonable period of time may be derived or ascertained is not responsive to this interrogatory. Opposer should provide the annual sales figures of each product or service identified in interrogatory 4a from the date of first use of each of Opposer's Marks on or in association with each product or service.

No. 6: In addition to providing the promised listing of all USPTO inter partes proceedings in which Opposer's Marks have been pleaded, Opposer should state the disposition or current status of each proceeding, and identify all documents relating thereto including particularly any settlements that may have been reached.

No. 7: Opposer has objected to this interrogatory as seeking confidential and attorney-client privileged and/or attorney work product information and material of Opposer. Opposer should provide sufficient identifying information for all documents responsive to this interrogatory.

No. 12: Opposer should identify all past or present third party uses or U.S. registrations of any names or marks including the term "BIG" or "BIGG" with respect to any goods or services marketed or sold in the automotive accessories, automotive repair services and automotive maintenance services and the particular goods or services with which the names or marks are used by each third party.

No. 13: Opposer should provide the factual basis for each of Opposer's allegations as stated in paragraphs 5-7 and 9-12 of Opposer's Notice of Opposition, a copy of which is attached hereto as Exhibit K. Also Applicant should provide sufficient identifying information for all documents responsive to this interrogatory.

B. DOCUMENT REQUESTS AND PRODUCTION

No. 1: In addition to providing representative samples of the current use of Opposer's Marks (which Opposer agreed to produce but has yet to

do so), Opposer should produce documents sufficient to show Opposer's continuing use of each of Opposer's Marks at least since prior to the filing date of June 18, 2003 of Applicant's BIGG WHEELS trademark application opposed herein.

No. 2: Opposer should produce all documents relating to any permission given by Opposer to any third party (not just franchisees of Opposer) to use a mark or trade name which Opposer considered or considers to be similar or identical to any of Opposer's Marks, including all documents permitting such use. If Opposer withholds any documents responsive to this request, Opposer should provide sufficient identifying information for any such withheld documents and the basis for withholding same.

No. 3: Opposer should produce all documents relating to any permission given by Opposer to any third party (not just franchisees of Opposer) to use a trademark, service mark or trade name constituting or including the term "BIG" or "BIGG", including all documents permitting such use. If Opposer withholds any documents responsive to this request, Opposer should provide sufficient identifying information for any such withheld documents and the basis for withholding same.

- No. 4: Opposer should produce all documents referring or relating to any permission received by Opposer from any third party to use any of Opposer's Marks, including all documents permitting such use. If Opposer withholds any documents responsive to this request, Opposer should provide sufficient identifying information for any such withheld documents and the basis for withholding same.
- No. 5: Opposer should produce all documents referring or relating to any objections Opposer has ever made to any third party, and any third party has made to Opposer, concerning the use of any mark or name which was considered to be confusingly similar to any of Opposer's Marks. If Opposer withholds any documents responsive to this request, Opposer should provide sufficient identifying information for any such withheld documents and the basis for withholding same.
- No. 6: Opposer should produce the documents Opposer already agreed to produce.
- No. 7: In addition to providing a listing of any action or proceeding in any court or other tribunal including but not limited to the USPTO filed by Opposer against a third party or filed by a third party against Opposer involving any of Opposer's Marks, Opposer should

produce all documents relating to any settlements that may have been reached in any such action or proceeding. If Opposer withholds any documents responsive to this request, Opposer should provide sufficient identifying information for any such withheld documents and the basis for withholding same.

Nos. 8-11, 13 and 14:

Opposer should produce the documents Opposer already agreed to produce.

Nos. 15, 17, 23, 25-31, 33-35 and 40:

Opposer should produce the documents Opposer already agreed to produce. If Opposer withholds any documents responsive to any of these requests, Opposer should provide sufficient identifying information for any such withheld documents and the basis for withholding same.

No. 37: Opposer should produce all documents referring or relating to any United States service mark or trademark registrations or applications issued to or filed by any third party for any mark incorporating "BIG" or "BIGG" alone or in combination with other words, letters or symbols. If Opposer withholds any documents responsive to this request, Opposer should provide sufficient

identifying information for any such withheld documents and the basis for withholding same.

No. 38: Opposer should produce all documents relating to any third party uses (not just franchisees of Opposer) of any mark or trade name incorporating "BIG" or "BIGG" alone or in combination with other words, letters or symbols. If Opposer withholds any documents responsive to this request, Opposer should provide sufficient identifying information for any such withheld documents and the basis for withholding same.

No. 41: Opposer should produce all documents relating to any objection, lawsuit, opposition proceeding, cancellation proceeding or other proceeding involving or relating to any of Opposer's Marks. If Opposer withholds any documents responsive to this request, Opposer should provide sufficient identifying information for any such withheld documents and the basis for withholding same.

No. 42: Opposer should produce all documents and things referenced or identified by Opposer in answer to Applicant's First Set of Interrogatories. If Opposer withholds any documents responsive to this request, Opposer should provide sufficient identifying

information for any such withheld documents and the basis for withholding same.

No. 43: Opposer should provide all documents and things requested to be identified by Opposer in answer to Applicant's First Set of Interrogatories. If Opposer withholds any documents responsive to this request, Opposer should provide sufficient identifying information for any such withheld documents and the basis for withholding same.

IV. CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Board grant Applicant's Motion to Compel and issue an Order requiring Opposer to produce the promised and responsive documents by mail and serve amended or supplemental answers to the foregoing Applicant's interrogatories and document requests.

Respectfully submitted,

WHEEL SPECIALTIES, LTD.

By Its Attorneys



Date: February 17, 2006

Donald L. Otto

Warren A. Sklar

RENNER, OTTO, BOISSELLE &
SKLAR, LLP

1621 Euclid Avenue

Nineteenth Floor

Cleveland, Ohio 44115-2191

Phone: 216-621-1113

Fax: 216-621-6165

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing APPLICANT'S MOTION TO COMPEL was served on the following attorney of record for Opposer by depositing same in the United States mail, postage prepaid, this 17th day of February, 2006.

Marsha G. Gentner
Matthew J. Cuccias
JACOBSON HOLMAN, PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004



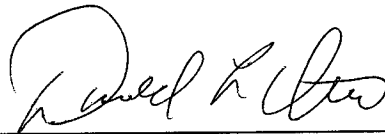
Donald L. Otto

CERTIFICATE OF MAILING

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

on **February 17, 2006.**



Donald L. Otto

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BIG O TIRES, INC.,)	OPPOSITION No: 91163791
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Opposer,)	SERIAL No: 78/264,260
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v.)	
)	
WHEEL SPECIALTIES, LTD.)	
)	
Applicant.)	

APPLICANT'S FIRST SET OF INTERROGATORIES

Pursuant to Rule 33 of the Federal Rules of Civil Procedure, and 37 CFR 2.120, Applicant, Wheel Specialties, Ltd. hereby requests that Opposer, Big O Tires, Inc., answer under oath the following interrogatories within thirty (30) days after service of such interrogatories.

DEFINITIONS

As used herein, the following definitions shall apply:

A. "Opposer" means and includes Big O Tires, Inc. as well as its predecessors, predecessors-in-interest, subsidiaries, licensees, directors, officers, employees, agents, representatives, attorneys and all other persons in privity with Opposer with respect to the matters herein inquired about.

B. "Applicant" means and includes Wheel Specialties Ltd. as well as its predecessors, predecessors-in-interest, subsidiaries, licensees, directors, officers, employees, agents, representatives, attorneys and all other persons in privity with applicant with respect to the matters herein inquired about.

C. The term "Opposer's Marks" means and includes each of the marks and registrations identified in paragraphs 2 and 3 of the Opposer's Notice of Opposition.

D. The term "Applicant's Mark" means and includes the mark BIGG WHEELS of Serial No. 78/264,260 opposed herein.

E. The term "person" shall mean and include both natural persons and corporate or other business entities, partnerships, groups, associations, governmental entities, or other organizations (including Applicant and Opposer), and the acts of a person are defined to include the acts of directors, officers, owners, members, employees, agents or attorneys acting on the person's behalf.

F. The term "document(s)" shall mean and include, without limitation thereto, the originals, absent any original a copy, of agreements, memoranda, notes (including laboratory notebooks and records), diaries, interoffice communications, tapes or other recordings, minutes, telegrams, letters, photographs, drawings, sketches, drafts, data, reports, charts, bulletins, circulars, advertisements, catalogs, publications, work assignments, work sheets, instructions, computer programs, or any other visually or orally reproduced materials, in the possession, custody or control of Opposer, its attorneys, employees or agents. Any copy of a "document" as hereinabove defined containing thereon or attached thereto any alteration, notes, comments or other mark, indicia or material not included in the originals or copies referred to in the preceding sentence shall be deemed a separate "document" within the foregoing definitions.

G. Wherever in the following interrogatories a request is made to "identify" items or documents, the term "identify" shall mean to supply sufficient information to permit identification under Federal Rules of Civil Procedure, Nos. 34 and 35, including the present whereabouts of the items or documents and the name and address of the custodian thereof. In the case of an interrogatory which requests the identification of documents, however, it will be considered a complete and sufficient answer if Opposer actually produces the documents requested to be identified, provided such documents are produced within the time allowed to answer these interrogatories or within such other time as the parties, through their respective counsel, mutually agree upon;

H. Whenever in the following interrogatories a request is made to "identify" persons, corporations, or other entities, the term "identify" means to supply the name of that person, corporation or other entity; and, in the first instance of identification of any given person, corporation or other entity, the term "identify" means to supply that person's, corporation's or other entity's name, present or last known residence address, present or last known business address, connection or title, if any, with the Opposer, and to state whether such person is considered to be an employee or agent of Opposer;

I. Any word written in the singular shall be construed as plural or vice-versa when necessary to facilitate the answer to a discovery request.

J. As used herein, the connectives "and" and "or" shall be construed either disjunctively or conjunctively, as necessary, to bring within the scope of the

discovery request all responses that might otherwise be construed to be outside of its scope.

K. If Opposer intends to claim a privilege with respect to any fact or document requested herein, identify and describe the privilege, and provide all of the pertinent unprivileged, identifying information respecting such fact or document specified above.

INSTRUCTIONS

These interrogatories are deemed continuing, so as to require supplemental answers promptly whenever Opposer obtains further information after the answers are filed, or learns that previous answers were not full and correct.

INTERROGATORIES

1. Describe the nature of the business conducted by Opposer.
2. Identify each and every place of business maintained by Opposer in the United States, its territories and/or possessions.
3. Identify each predecessor, predecessor-in-interest, parent, subsidiary and affiliated company of Opposer.
4. With respect to each product or service offered by Opposer on or in association with which Opposer uses one or more of Opposer's Marks:
 - a. Identify each product or service by supplying its generic name and which of Opposer's Marks is used on or in association with the product or service;

- b. state in detail how each product or service is marketed by or for Opposer;
- c. identify the marketing and trade channels for each product or service;
- d. identify the class of customers to whom Opposer offers or sells each product or service;
- e. give the inclusive dates during which Opposer has offered or sold each product or service under each of Opposer's Marks; and
- f. provide the annual sales figures of each product or service from the date of first use of each of Opposer's Marks on or in association with each product or service.

5. State whether or not Opposer is now or ever has been involved in any proceeding relating to any third party use of the term "BIG" or "BIGG" alone or in combination with any other words, letters or symbols, and if so, identify each proceeding by title or caption, tribunal, the parties and marks involved, the disposition or current status, and identify all documents relating thereto.

6. State whether or not Opposer is now or ever has been involved in any United States Patent and Trademark Office *inter partes* proceedings (including any oppositions or cancellations other than the present proceeding) which involves or relates to any of Opposer's Marks, and if so, identify each proceeding by title or caption, the parties and marks involved, the disposition or current status, and identify all documents relating thereto.

7. Identify any investigations, searches or surveys which Opposer has conducted or commissioned, or caused to be conducted or commissioned, relating to whether there is, or may be, a likelihood of confusion between the Applicant's BIGG WHEELS mark and any of Opposer's Marks.

8. State the date(s) and identify the circumstances under which Opposer first learned of the use of the mark BIGG WHEELS by Applicant and identify all documents constituting, memorializing, referring or relating thereto.

9. If Opposer has any information whatsoever concerning any possible instance of confusion between the Applicant's BIGG WHEELS mark and any of Opposer's Marks as to the source of any goods offered by Applicant under the BIGG WHEELS mark:

a. identify and describe in detail the circumstances surrounding each such instance, including the identity of the person possibly confused, the nature of the possible confusion, and the date and place of each such instance of possible confusion;

b. the manner in which such possible confusion was communicated or came to the attention of Opposer;

c. all persons having knowledge of such possible confusion;

d. the response, if any, made by or on behalf of Opposer; and

e. all documents which constitute, memorialize, relate or refer in any way to each such instance of possible confusion.

10. State whether Opposer or any person acting for or on behalf of Opposer has received any communications, oral or in writing, from any person

which suggest, imply or infer that Applicant may be connected or associated with Opposer in any way, or which comprise any inquiry as to whether there is or may be or which evidence any such connection or association, and if so, identify all documents which constitute, memorialize, relate or refer in any way to such communications.

11. Identify all documents on which Opposer intends to rely in connection with this opposition.

12. State whether Opposer is aware of any past or present third party uses or registrations of any names or marks including the term "BIG" or "BIGG" alone or in combination with any other words, letters or symbols with respect to any goods or services marketed or sold in the automotive aftermarket including but not limited to automotive parts, automotive accessories, automotive repair services and automotive maintenance services, and if so, identify each such third party and the names or marks and any United States registrations of the names or marks and the particular goods or services with which the names or marks are used or intended to be used.

13. State in detail each fact and all information (including, but not limited to each witness with personal knowledge of same) and identify all documents which evidence or support each of Opposer's allegations as stated in paragraphs 5-7 and 9-12 of Opposer's Notice of Opposition filed in this proceeding.

14. Identify each person who was consulted or in any way contributed to Opposer's answers to the foregoing interrogatories, and specify the information supplied by each.

Respectfully submitted,

WHEEL SPECIALTIES, LTD.
By Its Attorneys



Date: July 29, 2005

Donald L. Otto
Warren A. Sklar
RENNER, OTTO, BOISSELLE & SKLAR, LLP
1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115-2191
Phone: 216-621-1113
Fax: 216-621-6165

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing APPLICANT'S FIRST SET OF INTERROGATORIES was served on the following attorney of record for Opposer by depositing same in the United States mail, postage prepaid, this 29th day of July, 2005.

Marsha G. Gentner
Matthew J. Cuccias
JACOBSON HOLMAN, PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004



Donald L. Otto

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BIG O TIRES, INC.,)	OPPOSITION No: 91163791
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Opposer,)	SERIAL No: 78/264,260
)	
v.)	
)	
WHEEL SPECIALTIES, LTD.)	
)	
Applicant.)	

APPLICANT'S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, and 37 CFR 2.120, Applicant, Wheel Specialties, Ltd., hereby requests that Opposer, Big O Tires, Inc., produce for inspection and copying the following documents and other tangible things, within the possession, custody or control of Opposer at the offices of Applicant's attorneys, Renner, Otto, Boisselle & Sklar, LLP, 1621 Euclid Avenue, Nineteenth Floor, Cleveland, Ohio 44115-2191, or such other location as shall be mutually agreed upon by counsel for the parties, thirty (30) days following service hereof.

DEFINITIONS

The Definitions set forth in Applicant's first set of interrogatories, served concurrently herewith, are incorporated herein by reference and made a part hereof, as if fully stated herein.

INSTRUCTIONS

A. All documents responsive to these Requests shall be produced in the same form and in the same order in which they are kept in the usual course of business.

B. If Opposer refuses for any reason to produce any document requested, Opposer shall, individually as to each such document whose production is refused and on or before the date requested for production, state the grounds for such refusal and fully identify each such document whose production is refused by providing a brief description thereof sufficient to support a motion to compel discovery and including the general nature of the subject matter, the date, the author, the recipient (if any), the present depository and person having possession, custody, or control thereof and, if the document embodies an agreement, the persons involved in such agreement.

C. If a document is produced in redacted form, state with particularity the reasons it was not produced in full, and describe generally those portions of the document that are not being produced in a manner sufficient to identify the document for purposes of a motion to compel discovery.

D. The obligations to respond to these requests is intended to be of a continuing nature and Opposer is required to supplement the production of documents promptly upon obtaining additional information responsive to these requests.

REQUESTS FOR PRODUCTION

1. Documents sufficient to show or evidence Opposer's initial and continuing use of each of Opposer's Marks in connection with Opposer's goods or services offered under each of Opposer's Marks.
2. All documents constituting, memorializing, referring or relating to any permission given by Opposer to any third party to use a trademark, service mark or trade name which Opposer considered or considers to be similar or identical to any of Opposer's Marks, including all documents permitting such use.
3. All documents constituting, memorializing, referring or relating to any permission given by Opposer to any third party to use a trademark, service mark or trade name constituting or including the term "BIG" or "BIGG", including all documents permitting such use.
4. All documents constituting, memorializing, referring or relating to any permission received by Opposer from any third party to use any of Opposer's Marks, including all documents permitting such use.
5. All documents constituting, memorializing, referring or relating to any objections Opposer has ever made to any third party, and any third party has made to Opposer, concerning the use of any trademark, service mark or trade name which was considered to be confusingly similar to any of Opposer's Marks or any portion thereof.
6. All documents constituting, memorializing, referring or relating to any assignment of any trademark rights in any of Opposer's Marks.

7. All documents constituting, memorializing, referring or relating to any action or proceeding in any court or other tribunal including but not limited to the U.S. Patent and Trademark Office filed by Opposer against a third party or filed by a third party against Opposer involving any of Opposer's marks.

8. A sample of each non-identical label or other marking or depiction of same, used on or in connection with any goods or services offered under each of Opposer's Marks.

9. A sample of each and every type of advertising and other documents intended to promote any goods or services offered under each of Opposer's Marks.

10. A sample of each and every type of display used in connection with any goods or services offered under each of Opposer's Marks.

11. Documents sufficient to show or evidence the geographic scope of the advertising, distribution and sale or offer for sale of any goods or services offered under each of Opposer's Marks.

12. All documents concerning the transfer and chain of title of each of Opposer's Marks.

13. Documents sufficient to show or evidence the classes of customers to whom and channels of trade through which any goods or services are offered under each of Opposer's Marks.

14. All documents constituting, memorializing, referring or relating to any marketing or perception studies as to whether or not use of the mark BIGG WHEELS by Applicant and use of any of Opposer's Marks is likely to cause

confusion, to cause mistake, or to deceive customers as to source affiliation or sponsorship of the Applicant's and Opposer's goods or services.

15. All documents constituting, memorializing, referring or relating to any possible instances of confusion or mistake between the mark BIGG WHEELS of Applicant and any of Opposer's Marks.

16. All documents constituting, memorializing, referring or relating to when Opposer first became aware of Applicant's use of the mark BIGG WHEELS and of the application opposed herein.

17. All documents and things constituting, memorializing, referring or relating to any statements, inquiries, comments or other communications by or from Opposer's customers, distributors, suppliers or others, relating to the similarity or dissimilarity of Applicant's BIGG WHEELS mark to any of Opposer's Marks or evidencing any confusion, suspicion, belief or doubt on the part of any third party as to any relationship between the Applicant and Opposer or the respective goods or services offered under Applicant's BIGG WHEELS mark and any of Opposer's Marks, including any misdirected complaints or inquiries.

18. All documents constituting, memorializing, referring or relating to any communication, oral or written, received by Opposer from any person which suggests, implies or infers any connection or association of Applicant with Opposer or which inquires as to whether there is or may be any such connection or association.

19. All documents constituting, memorializing, referring or relating to any instance or occurrence of actual confusion on the part of any person between Applicant's BIGG WHEELS mark and any of Opposer's Marks.

20. All documents constituting, memorializing, referring or relating to any inquiry, investigation or survey conducted by or on behalf of Opposer regarding any issues involved in this proceeding.

21. All statements or opinions of any experts retained by Opposer or any person acting for or on behalf of Opposer regarding any of the issues involved in this proceeding.

22. All documents which evidence, support or show any claims made by Applicant in this proceeding.

23. Documents sufficient to show, explain or describe each of the products or services offered under each of Opposer's Marks.

24. A sample of each advertisement and promotional material mentioning or referring to each of Opposer's Marks and/or the goods or services offered under each of Opposer's Marks.

25. All documents which evidence, support or show each of the allegations contained in paragraph 5 of Opposer's Notice of Opposition.

26. All documents which evidence, support or show each of the allegations contained in paragraph 6 of Opposer's Notice of Opposition.

27. All documents which evidence, support or show each of the allegations contained in paragraph 7 of Opposer's Notice of Opposition.

28. All documents which evidence, support or show each of the allegations contained in paragraph 9 of Opposer's Notice of Opposition.

29. All documents which evidence, support or show each of the allegations contained in paragraph 10 of Opposer's Notice of Opposition.

30. All documents which evidence, support or show each of the allegations contained in paragraph 11 of Opposer's Notice of Opposition.

31. All documents which evidence, support or show each of the allegations contained in paragraph 12 of Opposer's Notice of Opposition.

32. All documents which refer or relate to Applicant.

33. All documents which refer or relate to Applicant's Mark.

34. All documents which refer or relate to Applicant's Products.

35. All documents which evidence, refer or relate to the time Opposer first learned of Applicant.

36. All documents which evidence, refer or relate to the time Opposer first became aware of Applicant's use of the mark BIGG WHEELS.

37. All documents constituting, memorializing, referring or relating to any United States service mark or trademark registrations or applications issued to or filed by any third party for any mark incorporating "BIG" or "BIGG" alone or in combination with other words, letters or symbols.

38. All documents constituting, memorializing, referring or relating to any third party uses of any trademark, service mark or trade name incorporating "BIG" or "BIGG" alone or in combination with other words, letters or symbols.

39. All documents which show, evidence or support Opposer's answers to Applicant's First Set of Interrogatories served concurrently herewith.

40. All documents which show, evidence or support Opposer's allegations that Applicant's Mark, as used on or in connection with Applicant's goods, is likely to be confused with Opposer's Marks.

41. All documents relating to any objection, lawsuit, opposition proceeding, cancellation proceeding or other proceeding involving or relating to any of Opposer's Marks.

42. All documents and things referenced or identified by Opposer in answer to Applicant's First Set of Interrogatories.

43. All documents and things requested to be identified by Opposer in answer to Applicant's First Set of Interrogatories.

44. All documents upon which Opposer intends to rely in the trial of this proceeding.

Respectfully submitted,

WHEEL SPECIALTIES, LTD.

By Its Attorneys

Date: July 29, 2005



Donald L. Otto

Warren A. Sklar

RENNER, OTTO, BOISSELLE & SKLAR, LLP

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Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing APPLICANT'S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS was served on the following attorney of record for Opposer by depositing same in the United States mail, postage prepaid, this 29th day of July, 2005.

Marsha G. Gentner
Matthew J. Cuccias
JACOBSON HOLMAN, PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004



Donald L. Otto

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Marsha G. Gentner, Esq.
Jacobson Holman PLLC
400 Seventh Street, NW
Washington, DC 20004

Re: Big O Tires, Inc. v. Wheel Specialties, Ltd.
Opposition N^o 91163791
Our File WHEL.L0101

Dear Ms. Gentner:

Enclosed are Applicant's First Set of Interrogatories and First Request for Production of Documents. Please provide us with Opposer's responses to these discovery requests within thirty days hereof pursuant to the Federal Rules of Civil Procedure.

Also enclosed are documents bearing Applicant's Production Nos. WSL 1-249 which are being produced in response to Opposer's First Request for Production of Documents.

Very truly yours,

Donald L. Otto

DLO:jm
enclosures
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BIG O TIRES, INC.,)	
)	
Opposer,)	
)	Opposition No. 91163791
vs.)	Serial No. 78/264260
)	
WHEEL SPECIALTIES, LTD.,)	
)	
Applicant.)	

**OPPOSER'S RESPONSES TO
APPLICANT'S FIRST SET OF INTERROGATORIES**

Opposer, Big O Tires, Inc., hereby responds to Applicant's First Set of Interrogatories.

These responses are made in accordance with F.R.Civ.P. 33 and Rule 2.120 of the Trademark Rules of Practice, and are based upon the best information presently available to Opposer, but are made without prejudice to the right of Opposer to make additional or modified answers should better or further information or belief become available to Opposer, and without prejudice to any right of Opposer to offer evidence on its behalf, or to object to the relevance, competence or admissibility of any evidence offered by Applicant at the trial, or other proceedings, on any ground.

GENERAL OBJECTIONS

A. Opposer objects to the Definitions (including but not limited to the definition of "Opposer"), Discovery Requests, and Interrogatories to the extent they seek to require Opposer to provide information for any non-party to this opposition, including, but not limited to, Opposer's franchisees and Opposer's attorneys.

B. Opposer objects to the definition of "Applicant" as confusing and vague.

C. Opposer objects to the Definitions, Instructions and Discovery Requests to the extent that they seek to impose any obligation beyond that required under the Federal Rules of Civil Procedure and/or the Trademark Rules of Practice.

D. Opposer objects to the Definitions, Instructions and Discovery Requests to the extent that they are vague, overly broad, unduly burdensome, and to the extent they seek the confidential and/or attorney-client privileged and/or attorney work product information and/or materials of Opposer.

ANSWERS TO INTERROGATORIES

INTERROGATORY NO. 1:

Describe the nature of the business conducted by Opposer.

OBJECTION AND RESPONSE:

Opposer objects to this interrogatory as vague, confusing, and indefinite. Subject to, and without waiver of, its objections, Opposer is engaged in the retail sale of vehicle products, including vehicle tires and wheels, and services, including tire/wheel-related services; and franchise services in connection with vehicle products and services.

INTERROGATORY NO. 2:

Identify each and every place of business maintained by Opposer in the United States, its territories and/or possessions.

OBJECTION AND RESPONSE:

Opposer objects to this interrogatory as overly broad and irrelevant. Subject to, and without waiver of, its objections, Opposer's corporate office is located at 12650 East Briarwood

Avenue, Centennial, CO 80112. Additionally, Opposer will produce a directory of Big O stores.

INTERROGATORY NO. 3:

Identify each predecessor, predecessor-in-interest, parent, subsidiary and affiliated company of Opposer.

OBJECTION AND RESPONSE:

Opposer objects to this interrogatory as vague, confusing, overly broad, indefinite, irrelevant and to the extent that it seeks the confidential information of Opposer. Subject to, and without waiver of, its objections, Carroll Tire Company, Tire Kingdom, Northern States Tire, TBC Brands, LLC., TBC Corp., TBC de Mexico, Superior Tire, and National Tire and Battery. Opposer will not provide a list of each franchisee.

INTERROGATORY NO. 4:

With respect to each product or service offered by Opposer on or in association with which Opposer uses one or more of Opposer's Marks:

- a. Identify each product or service by supplying its generic name and which of Opposer's marks is used on or in association with the product or service;
- b. state in detail how each product or service is marketed by or for Opposer;
- c. identify the marketing and trade channels for each product or service;
- d. identify the class of customers to whom Opposer offers or sells each product or service;
- e. give the inclusive dates during which Opposer has offered or sold each product or service under each of Opposer's Marks; and
- f. provide the annual sales figures of each product or service from the date of first use of each of Opposer's Marks on or in association with each product or service.

OBJECTION AND RESPONSE:

Opposer objects to this interrogatory as vague, confusing, overly broad, unduly burdensome, irrelevant and indefinite and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections,

a. tires; batteries, vehicle parts (wheels, brakes, shock absorbers, struts); retail tire store services; retail stores featuring tires, vehicle parts and accessories; vehicle maintenance and repair services; shuttle services; tire/wheel services; apparel, hats, patches/buttons, and various specialty items, namely, CD visor holders, funnels, ice scrapers, litterbags, utility tool pouches, jelly cell mates, first aid kits, visor notebooks, antenna balls, air gauges, bottle opener key chains, soft plastic key fobs, frisbees, pens and pencils, highlighters, carabineer key chains, mint dispensers, lollipops, bumper stickers, notebooks including calculators, tape measurers, stress balls, calculators, stadium cups, coffee mugs, can coolers, polycarbonate bottles, clocks, towels, golf zipper pouches, pennants, and balloons; and franchising services. Additionally, Opposer's franchisees sell and/or offer other vehicular parts, products, accessories and/or services;

b. goods and vehicle/tire services: retail stores; franchise services: direct marketing to actual and prospective franchisees;

c. goods and vehicle/tire services: retail stores; franchise services: direct marketing to actual and prospective franchisees;

d. goods and vehicle services: any one who uses, owns, or leases a vehicle, and/or buys parts and/or services for a vehicle; franchise services: prospective business owners;

e. 1963 through present; and

f. pursuant to the entry of a mutually acceptable protective order, Opposer will produce documents from which Opposer's annual sales figures for a reasonable period may be derived or ascertained.

INTERROGATORY NO. 5:

State whether or not Opposer is now or ever has been involved in any proceeding relating to any third party use of the term "BIG" or "BIGG" alone or in combination with any other words, letters or symbols, and if so, identify each proceeding by title or caption, tribunal, the parties and marks involved, the disposition or current status, and identify all documents relating thereto.

OBJECTION AND RESPONSE:

Opposer objects to this interrogatory as vague, indefinite, overly broad, unduly burdensome, irrelevant, and as seeking the confidential, attorney-client privileged, and/or attorney work product information and/or materials of Opposer. Subject to, and without waiver of its objections, Opposer has been involved in lawsuits involving the third party use of a mark comprising the term "BIG": *Big O Tires, Inc. v. Bigfoot 4x4, Inc. and Vulcan Chain and Webbing Products, Inc.*, venued in the United States District Court for the District of Colorado, Civil Action No. 1 B 0349, Final Order and permanent injunction entered against Defendants; *see also Big O Tire Dealers, Inc. v. Good Year Tire and Rubber Co.*, 408 F. Supp. 1219 (D. Colo. 1976).

INTERROGATORY NO. 6:

State whether or not Opposer is now or ever has been involved in any United States Patent and Trademark Office *inter partes* proceedings (including any oppositions or cancellations other than the present proceeding) which involves or relates to any of Opposer's Marks, and if so, identify each proceeding by title or caption, the parties and marks involved, the disposition or current status, and identify all documents relating thereto.

OBJECTION AND RESPONSE:

Opposer objects to this interrogatory as vague, indefinite, overly broad, unduly burdensome, irrelevant, and to the extent that it seeks the confidential, attorney-client privileged, and/or attorney work product information and/or materials of Opposer. Subject to, and without waiver of its objections, Opposer is and has been involved in *inter partes* proceedings; pursuant to the entry of a mutually acceptable Protective Order, Opposer will provide a listing of Trademark Trial and Appeal Board proceedings in which its marks have been pleaded.

INTERROGATORY NO. 7:

Identify any investigations, searches or surveys which Opposer has conducted or commissioned, or caused to be conducted or commissioned, relating to whether there is, or may be, a likelihood of confusion between the Applicant's BIGG WHEELS mark and any of Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer objects to this interrogatory as vague, indefinite, overly broad, unduly burdensome, and as seeking the confidential and attorney-client privileged and/or attorney work product information and material of Opposer.

INTERROGATORY NO. 8:

State the date(s) and identify the circumstances under which Opposer first learned of the use of the mark BIGG WHEELS by Applicant and identify all documents constituting, memorializing, referring or relating thereto.

OBJECTION AND RESPONSE:

Opposer objects to this interrogatory as vague, indefinite, overly broad, unduly burdensome, irrelevant, assuming facts not in evidence, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections and subject to further discovery, Opposer is not currently aware of Applicant's use of the mark BIGG WHEELS.

INTERROGATORY NO. 9:

If Opposer has any information whatsoever concerning any possible instance of confusion between the Applicant's BIGG WHEELS mark and any of Opposer's Marks as to the source of any goods offered by Applicant under the BIGG WHEELS mark:

- a. identify and describe in detail the circumstances surrounding each such instance, including the identity of the person possibly confused, the nature of the possible confusion, and the date and place of each such instance of possible confusion;
- b. the manner in which such possible confusion was communicated or came to the attention of Opposer;
- c. all persons having knowledge of such possible confusion;
- d. the response, if any, made by or on behalf of Opposer; and
- e. all documents which constitute, memorialize, relate or refer in any way to each such instance of possible confusion.

OBJECTION AND RESPONSE:

Opposer objects to this interrogatory as vague, indefinite, overly broad, unduly burdensome, assuming facts not in evidence, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer, and as an improper attempt to require Opposer to present its case before trial.

INTERROGATORY NO. 10:

State whether Opposer or any person acting for or on behalf of Opposer has received any communications, oral or in writing, from any person which suggest, imply or infer that Applicant may be connected or associated with Opposer in any way, or which comprise any inquiry as to whether there is or may be or which evidence any such connection or association, and if so, identify all documents which constitute, memorialize, relate or refer in any way to such communications.

OBJECTION AND RESPONSE:

Opposer objects to this interrogatory as vague, indefinite, overly broad, unduly burdensome, assuming facts not in evidence, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, Opposer is not currently aware of any concurrent usage of Opposer's pleaded marks and the opposed mark at any time for the goods set forth in the opposed application in the same geographic area and/or such communications.

INTERROGATORY NO. 11:

Identify all documents on which Opposer intends to rely in connection with this position.

OBJECTION AND RESPONSE:

Opposer objects to this interrogatory to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, Opposer has not yet determined the documents it will rely on at trial.

INTERROGATORY NO. 12:

State whether Opposer is aware of any past or present third party uses or registrations of any names or marks including the term "BIG" or "BIGG" alone or in combination with any other words, letters or symbols with respect to any goods or services marketed or sold in the automotive accessories, automotive repair services and automotive maintenance services, and if so, identify each such third party and the names or marks and any United States registrations of the names or marks and the particular goods or services with which the names or marks are used or intended to be used.

OBJECTION AND RESPONSE:

Opposer objects to this interrogatory as vague, indefinite, overly broad, unduly burdensome, irrelevant, and as seeking the confidential, attorney-client privileged, and/or attorney work product information and/or materials of Opposer. Subject to, and without waiver of its objections, *see* Answer to Interrogatory Nos. 5 and 6.

INTERROGATORY NO. 13:

State in detail each fact and all information (including, but not limited to each witness with personal knowledge of same) and identify all documents which evidence or support each of Opposer's allegations as stated in paragraphs 5-7 and 9-12 of Opposer's Notice of Opposition filed in this proceeding.

OBJECTION AND RESPONSE:

Opposer objects to this interrogatory as vague, indefinite, overly broad, unduly burdensome, as seeking the confidential, attorney-client privileged, and/or attorney work product information and/or materials of Opposer, and as an improper attempt to require Opposer to present its case and evidence before trial.

INTERROGATORY NO. 14:

Identify each person who was consulted or in any way contributed to Opposer's answers to the foregoing interrogatories, and specify the information supplied by each.

OBJECTION AND RESPONSE:

Opposer objects to this interrogatory as irrelevant, vague, indefinite, and as seeking the attorney-client privileged information and material and/or attorney work product information of Opposer.

As to objections:

By: _____

Marsha G. Gentner
Matthew J. Cuccias
JACOBSON HOLMAN, PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004
(202) 638-6666

Dated: September 9, 2005

Attorneys for Opposer

As to Answers:

BIG O TIRES, INC.

By: _____

Name: _____

Title: _____

Subscribed and sworn to before me this _____ day of _____, 200____

Notary Public

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing *Opposer's Responses to Applicant's First Set of Interrogatories* was served on this 9th day of September, 2005, by first class mail, postage prepaid, addressed to:

Donald L. Otto
Attorneys for Applicant
Renner, Otto, Boisselle & Sklar, LLP
1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115-2191

Sheryl S. Harris

Opposition No. 91163791
Serial No. 78/264260

- B. Opposer incorporates by reference as if fully set forth herein, its objections to Applicant's Definitions, Instructions and Discovery Requests as stated in Opposer's Answers to Applicant's First Set of Interrogatories.

C. Opposer objects to Instructions B and C as improper interrogatories in the context of these requests.

RESPONSES TO REQUEST FOR PRODUCTION OF DOCUMENTS

REQUEST NO. 1:

Documents sufficient to show or evidence Opposer's initial and continuing use of each Opposer's Marks in connection with Opposer's goods or services offered under each of Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, unduly burdensome, overly broad, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, Opposer will produce representative samples of the current use of its marks.

REQUEST NO. 2:

All documents constituting, memorializing, referring or relating to any permission given by Opposer to any third party to use a trademark, service mark or trade name which Opposer considered or considers to be similar or identical to any of Opposer's Marks, including all documents permitting such use.

OBJECTION AND RESPONSE:

Opposer objects to this request as confusing, vague, indefinite, overly broad, unduly burdensome, and as seeking the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, pursuant to a mutually acceptable Protective Order entered by the Board,

Opposer will produce a sample of its franchise license with respect to its pleaded marks.

REQUEST NO. 3:

All documents constituting, memorializing, referring or relating to any permission given by Opposer to any third party to use a trademark, service mark, or trade name constituting or including the term "BIG" or "BIGG", including all documents permitting such use.

OBJECTION AND RESPONSE:

Opposer objects to this request as confusing, vague, indefinite, overly broad, unduly burdensome, and as seeking the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, pursuant to a mutually acceptable Protective Order entered by the Board, Opposer will produce a sample of its franchise license with respect to its pleaded marks.

REQUEST NO. 4:

All documents constituting, memorializing, referring or relating to any permission received by Opposer from any third party to use any of Opposer's Marks, including all documents permitting such use.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, confusing, vague, indefinite, overly broad, unduly burdensome, and as seeking the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, pursuant to a mutually acceptable Protective Order entered by the Board, Opposer will produce responsive documents.

REQUEST NO. 5:

All documents constituting, memorializing, referring or relating to any objections Opposer has ever made to any third party, and any third party has made to Opposer, concerning the use of any trademark, service mark or trade name which was considered to be confusingly similar to any of Opposer's Marks or any portion thereof.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, *see* Opposer's responses to interrogatories nos. 5 and 6.

REQUEST NO. 6:

All documents constituting, memorializing, referring or relating to any assignment of any trademark rights in any of Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, pursuant to a mutually acceptable Protective Order entered by the Board, Opposer will produce any such assignment(s).

REQUEST NO. 7:

All documents constituting, memorializing, referring or relating to any action or proceeding in any court or other tribunal including but not limited to the U.S. Patent and Trademark Office filed by Opposer against a third party or filed by a third party against Opposer involving any of Opposer's marks.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, *see* Opposer's responses to interrogatories nos. 5 and 6.

REQUEST NO. 8:

A sample of each non-identical label or other marking or depiction of same, used on or in connection with any goods or services offered under each of Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer objects to this request as vague, indefinite, unduly burdensome, overly broad, and irrelevant. Subject to, and without waiver of, its objections, Opposer will produce representative samples.

REQUEST NO. 9:

A sample of each and every type of advertising and other documents intended to promote any goods or services offered under each of Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer objects to this request as confusing, vague, indefinite, unduly burdensome, overly broad and irrelevant. Subject to, and without waiver of, its objections, Opposer will produce representative samples of its advertising materials.

REQUEST NO. 10:

A sample of each and every type of display used in connection with any goods or services offered under each of Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer objects to this request as vague, indefinite, unduly burdensome, overly broad and irrelevant. Subject to, and without waiver of, its objections, Opposer will produce representative sample(s) of in-store displays.

REQUEST NO. 11:

Documents sufficient to show or evidence the geographic scope of advertising, distribution and sale or offer for sale of any goods or services offered under each of Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer will produce responsive documents.

REQUEST NO. 12:

All documents concerning the transfer and chain of title of each of Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, *see* response to Request No. 6.

REQUEST NO. 13:

Documents sufficient to show or evidence the classes of customers to whom and channels of trade through which any goods or services are offered under each of Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, documents produced by Opposer will be responsive to this request.

REQUEST NO. 14:

All documents constituting, memorializing, referring or relating to any marketing or perception studies as to whether or not use of the mark BIGG WHEELS by Applicant and use of any of Opposer's Marks is likely to cause confusion, to cause mistake, or to deceive customers as to source affiliation or sponsorship of the Applicant's and Opposer's goods or services.

OBJECTION AND RESPONSE:

Opposer objects to this request as vague, indefinite, overly broad, unduly burdensome, assuming facts not in evidence, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, and to the extent understood, there are no such documents.

REQUEST NO. 15:

All documents constituting, memorializing, referring or relating to any possible instances of confusion or mistake between the mark BIGG WHEELS of Applicant and any of Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer objects to this request as vague, indefinite, overly broad, unduly burdensome, as seeking the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer, and as an improper attempt to require Opposer to present its case before trial. Subject to, and without waiver of, its objections, documents produced by Opposer will be responsive to this request.

REQUEST NO. 16:

All documents constituting, memorializing, referring or relating to when Opposer first became aware of Applicant's use of the mark BIGG WHEELS and of the application opposed herein.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, assuming facts not in evidence, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, Opposer is not currently aware of the actual use of Applicant's Mark.

REQUEST NO. 17:

All documents and things constituting, memorializing, referring or relating to any statements, inquiries, comments or other communications by or from Opposer's customers, distributors, suppliers or others, relating to the similarity or dissimilarity of Applicant's BIGG WHEELS mark to any of Opposer's Marks or evidencing any confusion, suspicion, belief or doubt on the part of any third party as to any relationship between the Applicant and Opposer or the respective goods or services offered under Applicant's BIGG WHEELS mark and any of Opposer's Marks, including any misdirected complaints or inquiries.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, assuming facts not in evidence, irrelevant, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, documents produced by Opposer will be responsive to this request.

REQUEST NO. 18:

All documents constituting, memorializing, referring or relating to any communication, oral or written, received by Opposer from any person which suggests, implies or infers any connection or association of Applicant with Opposer or which inquires as to whether there is or may be any such connection or association.

OBJECTION AND RESPONSE:

Opposer objects to this request as vague, indefinite, overly broad, unduly burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, Opposer is not currently aware of such documents.

REQUEST NO. 19:

All documents constituting, memorializing, referring or relating to any instance or occurrence of actual confusion on the part of any person between Applicant's BIGG WHEELS mark and any of Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer objects to this request as vague, indefinite, assuming facts not in evidence, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, Opposer is not currently aware of such documents or any concurrent usage of Opposer's pleaded marks and the opposed mark at any time for the goods set forth in the opposed application in the same geographic area.

REQUEST NO. 20:

All documents constituting, memorializing, referring or relating to any inquiry, investigation or survey conducted by or on behalf of Opposer regarding any issues involved in this proceeding.

OBJECTION AND RESPONSE:

Opposer objects to this request as unintelligible, vague, indefinite, overly broad, unduly burdensome, and as seeking the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer.

REQUEST NO. 21:

All statements or opinions of any experts retained by Opposer or any person acting for or on behalf of Opposer regarding any of the issues involved in this proceeding.

OBJECTION AND RESPONSE:

Opposer objects to this request as seeking the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, Opposer has not yet decided whether to retain any expert(s).

REQUEST NO. 22:

All documents which evidence, support or show any claims made by Applicant in this proceeding.

OBJECTION AND RESPONSE:

Opposer objects to this request and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of

Opposer. Subject to, and without waiver of, its objections, there are no documents.

REQUEST NO. 23:

Documents sufficient to show, explain or describe each of the products or services offered under each of Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer objects to this request as vague, indefinite, overly broad, unduly burdensome, irrelevant, and to the extent that it seeks the confidential information of Opposer. Subject to, and without waiver of, its objections, Opposer will produce responsive documents.

REQUEST NO. 24:

A sample of each advertisement and promotional material mentioning or referring to each of Opposer's Marks and/or the goods or services offered under each of Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer objects to this request as confusing, vague, indefinite, unduly burdensome, overly broad, and irrelevant. Subject to, and without waiver of, its objections, Opposer will produce representative samples of its advertising materials.

REQUEST NO. 25:

All documents which evidence, support or show each of the allegations contained in paragraph 5 of Opposer's Notice of Opposition.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly

burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, documents produced by Opposer will be responsive to this request.

REQUEST NO. 26:

All documents which evidence, support or show each of the allegations contained in paragraph 6 of Opposer's Notice of Opposition.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, documents produced by Opposer will be responsive to this request.

REQUEST NO. 27:

All documents which evidence, support or show each of the allegations contained in paragraph 7 of Opposer's Notice of Opposition.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, documents produced by Opposer will be responsive to this

request.

REQUEST NO. 28:

All documents which evidence, support or show each of the allegations contained in paragraph 9 of Opposers's Notice of Opposition.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, documents produced by Opposer will be responsive to this request.

REQUEST NO. 29:

All documents which evidence, support or show each of the allegations contained in paragraph 10 of Opposers's Notice of Opposition.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, documents produced by Opposer will be responsive to this request.

REQUEST NO. 30:

All documents which evidence, support or show each of the allegations contained in paragraph 11 of Opposer's Notice of Opposition.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, documents produced by Opposer will be responsive to this request.

REQUEST NO. 31:

All documents which evidence, support or show each of the allegations contained in paragraph 12 of Opposer's Notice of Opposition.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, documents produced by Opposer will be responsive to this request.

REQUEST NO. 32:

All documents which refer or relate to Applicant.

OBJECTION AND RESPONSE:

Opposer objects to this request as vague, indefinite, overly broad, unduly burdensome, irrelevant, and to the extent that it seeks the confidential and attorney-client privileged and/or attorney work product information and/or materials of Opposer.

REQUEST NO. 33:

All documents which refer or relate to Applicant's Mark.

OBJECTION AND RESPONSE:

Opposer objects to this request as vague, indefinite, overly broad, unduly burdensome, irrelevant and to the extent that it seeks the confidential and attorney-client privileged and/or attorney work product information and/or materials of Opposer. Subject to, and without waiver of its objections, Opposer will produce non-privileged work-product documents responsive to this request.

REQUEST NO. 34:

All documents which refer or relate to Applicant's Products.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, assuming facts not in evidence, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, Opposer will produce non-privileged work-product documents responsive to this request.

REQUEST NO. 35:

All documents which evidence, refer or relate to the time Opposer first learned of Applicant.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, unduly burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, documents produced by Opposer will be responsive to this request.

REQUEST NO. 36:

All documents which evidence, refer or relate to the time Opposer first became aware of Applicant's use of the mark BIGG WHEELS.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, and unduly burdensome, and to the extent that it seeks the attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, none.

REQUEST NO. 37:

All documents constituting, memorializing, referring or relating to any United States service mark or trademark registrations or applications issued to or filed by any third party for any mark incorporating "BIG" or "BIGG" alone or in combination with other words, letters or symbols.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, confusing, vague, indefinite, overly broad,

unduly burdensome, as requesting public record documents equally available to Applicant, and as seeking the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer.

REQUEST NO. 38:

All documents constituting, memorializing, referring or relating to any third party uses of any trademark, service mark or trade name incorporating "BIG" or "BIGG" alone or in combination with other words, letters or symbols.

OBJECTION AND RESPONSE:

Opposer objects to this request as confusing, vague, indefinite, overly broad, unduly burdensome, and as seeking the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, pursuant to a mutually acceptable Protective Order entered by the Board, Opposer will produce a sample of its franchise license with respect to its pleaded marks.

REQUEST NO. 39:

All documents which show, evidence or support Opposer's answers to Applicant's First Set of Interrogatories served concurrently herewith.

OBJECTION AND RESPONSE:

Opposer objects to this request as vague, irrelevant, indefinite, overly broad, unduly burdensome, as an improper attempt to require Opposer to present its case before trial, and as seeking the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer.

REQUEST NO. 40:

All documents which show, evidence or support Opposer's allegations that Applicant's Mark, as used on or in connection with Applicant's goods, is likely to be confused with Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer objects to this request as vague, indefinite, irrelevant, overly broad, unduly burdensome, as an improper attempt to require Opposer to present its case before trial, and as seeking the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, documents produced by Opposer will be responsive to the request.

REQUEST NO. 41:

All documents relating to any objection, lawsuit, opposition proceeding, cancellation proceeding or other proceeding involving or relating to any of Opposer's Marks.

OBJECTION AND RESPONSE:

Opposer objects to this request as irrelevant, vague, indefinite, overly broad, unduly burdensome, and to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, *see* Opposer's responses to interrogatories nos. 5 and 6.

REQUEST NO. 42:

All documents and things referenced or identified by Opposer in answer to Applicant's First Set of Interrogatories.

OBJECTION AND RESPONSE:

Opposer objects to this request as vague and indefinite, *see also* Opposer's Responses to Applicant's First Set of Interrogatories.

REQUEST NO. 43:

All documents and things requested to be identified by Opposer in answer to Applicant's First Set of Interrogatories.

OBJECTION AND RESPONSE:

Opposer objects to this request as vague and indefinite, *see also* Opposer's Responses to Applicant's First Set of Interrogatories.

REQUEST NO. 44:

All documents upon which Opposer intends to rely in the trial of this proceeding.

OBJECTION AND RESPONSE:

Opposer objects to this request to the extent that it seeks the confidential and/or attorney-client privileged information and material and/or attorney work product information of Opposer. Subject to, and without waiver of, its objections, Opposer has not yet determined the documents it intends to rely on at trial.

BIG O TIRES, INC.

Date: September 9, 2005

By: 

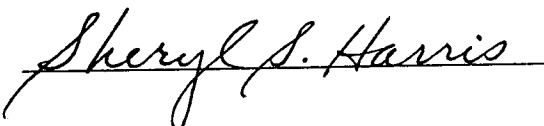
Marsha G. Gentner
Jacobson Holman PLLC
400 7th Street, NW
Washington, DC 20004
(202) 638-6666

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing *Opposer's Responses to Applicant's First Request for Production of Documents* was served on this 9th day of September, 2005, by first class mail, postage prepaid, addressed to:

Donald L. Otto
Warren A. Sklar
Attorneys for Applicant
Renner, Otto, Boisselle & Sklar, LLP
1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115-2191





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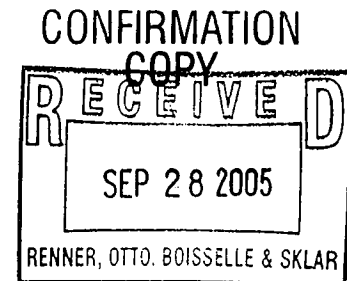
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September 26, 2005

Donald L. Otto, Esquire
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Via Facsimile
(216) 621-6165
Seven (7) pages
Confirmation copy by mail

Re: Opposition No. 163,791
Big O Tires, Inc. vs. Wheel Specialties, Ltd.
BIGG WHEELS – Serial No. 78/264,260
Our Reference: 11386/I-5156



Dear Mr. Otto:

After our review of Applicant's responses to Opposer's discovery requests, we have the following concerns.

Confidentiality

Applicant has refused to provide answers to certain requests and produce numerous documents on the basis of their confidential nature. Accordingly, we propose that the parties adopt the Board's Standard Order. Please advise if this is acceptable to Applicant.

General Comments on the Responses

Applicant seeks to interpose numerous objections to Opposer's interrogatories and document requests, covering the first three (3) pages of Applicant's responses (*e.g.*, "Each of the foregoing objections is applicable to all of the following responses and is incorporated herein."). This is improper since it does not put Opposer on notice as to the nature of the allegedly objectionable request or whether any response has been limited on the basis of any such objection. The objections should be withdrawn.

We now turn to Applicant's responses to specific discovery requests. The comments below are to be read in conjunction with appropriate discovery request and response. Moreover, the characterization of the discovery requests in this letter is not intended to, and does not, restrict the scope of the requests, as served.

Jacobson Holman PLLC

Donald L. Otto, Esquire
September 26, 2005
Page 2

Interrogatories

- No. 1: Interrogatory 1(a) is unanswered. Additionally, the "exemplary documents evidencing" use of Applicant's mark are not entirely legible. Please forward better copies.
- No. 2(c): Please confirm that Applicant will provide the requested information once a Protective Order is entered.
- No. 2(d): While Applicant objects to providing price information here, it agreed – without interposing a confidentiality objection – to "produce documents sufficient to show the price of the goods sold under Applicant's Mark." *See* document response no. 62. Please provide the requested information.
- No. 2(e): Please identify each state in which Applicant's products have been sold in connection with Applicant's mark.
- No. 3: Applicant's answer is deficiently narrow. For example, Applicant has not responded as to "searches or other investigations" related to Applicant's mark or the term(s) BIGG/BIG. Please supplement.
- No. 4(a): Please confirm that Applicant will provide the requested information once a Protective Order is entered.
- No. 4(b): This answer is insufficient as to Applicant's activities in light of Definition P. Additionally, please specify Applicant's customer's activities.
- No. 6: This answer is insufficient in light of Definition O; please supplement.
- No. 8: Please provide the business address, occupation and business position held for Messrs. Lamb and Nicols.
- Additionally, Applicant has not "describe[d] in detail" the reasons for selecting Applicant's BIGG WHEELS mark. Please supplement.
- No. 10: Please provide more information concerning the claimed Big O–Custom Wheel transaction of August, 2002 (*e.g.*, brand of vehicle wheels, *etc.*). *See* Definition K. The single document Applicant produced does not suffice. Please supplement.

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Applicant has not responded as to the circumstances under which it first became aware of Opposer's Mark, Opposer's stores, the actual or possible use of Opposer's Mark, and the goods and services bearing Opposer's Mark. We note that, at a minimum, Applicant was aware of, and visited, Opposer's stores before it selected Applicant's mark. *See* no. 7-8. Please supplement.

- No. 11: The response is too limited. For example, Applicant has not responded as to its consideration of Opposer. Applicant has admitted that it had actual knowledge of Opposer prior to Applicant's selection of Applicant's mark. *See* response to admission request no. 6.
- No. 12: Use of the limiting phrase "at least" in describing the relevant registrations is unacceptable. Please supplement with an identification of "each and every" such registration; failing which we will move to exclude any testimony or evidence which Applicant seeks to introduce at trial that is based on information responsive to this request.
- No. 15: Applicant's answer refers to documents to be produced. As discussed during the oral hearing, this answer constitutes an improper use of Rule 33(d) of the Federal Rules of Civil Procedure. As an initial matter, the referenced documents are not Applicant's "business records." Moreover, the requested information is not found on the documents Applicant produced on August 22, 2005. Furthermore, the burden of deriving the requested information falls more heavily on Opposer. Thus, Opposer demands a written response to the interrogatory where all of the requested information is provided for each responsive mark – if Applicant does not know or does not have the requested information, it should so state.
- No. 22: This interrogatory sought an identification of each request for which Applicant a) has not or will not produce documents; and b) there are no responsive documents. Applicant's reference to its responses to Opposer's document requests is not responsive. As an initial matter, Applicant's Objection No. 10 states that

Applicant's statement that responsive documents will be produced or will be made available for inspection and copying is not and should not be taken as an affirmative indication that responsive documents exist. Rather, the statement only indicates that if discoverable responsive documents do exist, they will be made available.

Donald L. Otto, Esquire
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Thus, this objection contradicts Applicant's apparent reliance on its responses to Opposer's document requests.

Moreover, use of the term "any" in many of Applicant's document responses – "Applicant will produce any relevant non-privileged and/or non-confidential documents responsive to this request" – further demonstrates the need for a written response to the interrogatory.

Admissions

Applicant denied several requests presumably because the term "Opposer's Marks" was not defined. *See e.g.*, response nos. 51, 55, 56, 94, 100 - 107. However, this term was defined. *See* Definition D in Opposer's First Set of Interrogatories, which was incorporated by reference into Opposer's First Set of Requests for Admission. Please supplement Applicant's answers.

Applicant admits that, prior to Applicant's selection of Applicant's mark, Applicant had actual knowledge of Opposer and Opposer's stores; and had visited one of Opposer's stores. *See* responses to nos. 6-8. Presumably, Applicant also had actual knowledge of Opposer's Mark, at least, "BIG O" and/or "BIG O TIRES" (no. 1) and use of the mark in connection with tires and automotive services (nos. 3-5, 12-14, and 21-23). Please amend.

We note that Applicant has mistyped the parenthetical of request no. 61 – it is not "(other than markets involved in this proceeding)" but rather "(other than marks involved in this proceeding)." Please amend.

Applicant admits that it possesses documents supporting Applicant's affirmative defenses, namely, Applicant's first, second, third, fourth, and sixth affirmative defenses (*see* nos. 66, 69, 72, 75 and 81). However, Applicant admits that it has not produced such documents (*see* nos. 68, 71, 74, 77, and 83). Similarly, Applicant admits that it possess documents supporting various contentions made in papers filed with the Trademark Office its Answer (*see* no. 84), but that such documents have not been produced (*see* nos. 86). All of these documents were requested, are responsive and must be produced immediately.

Please explain the basis for Applicant's denial of request nos. 95 and 96 that tires are not similar or related to wheels.

Donald L. Otto, Esquire
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Page 5

Document Responses and Production

We received Applicant's document production (WSL00001 – WSL00249) under your cover letter of July 29, 2005. The production is quite limited and basically includes: a third party catalog, a single advertisement, excerpts from Applicant's website(s), a couple of invoices, the prosecution history of the opposed application, and, ostensibly, some Internet printouts of third party references. Please supplement Applicant's document production.

Additionally, we note that Applicant has failed to identify which documents are responsive to which document requests. As you know, the Trademark Rules require that a party producing documents by mail "organize and label them to correspond with the categories in the requests." *See* TBMP § 406.04(b). However, Applicant did not produce its documents in this fashion, but should do so now.

We now turn to Applicant's responses to Opposer's document requests, many of which are deficient on a number of grounds.

First, many responses do not state whether responsive documents exist or will be produced. *See e.g.* response nos. 1-4, 14 - 28, 35 - 37, 45-46, 48, 52-54, and 60-61. This is improper. *See* TBMP §406.04(b); *see also, No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (a proper response requires stating as to each request either that there are responsive documents and they will be produced [or withheld on a claim of privilege] or stating party has no responsive documents). Accordingly, Applicant must state as to each request whether it has responsive documents, whether it will produce them, and to then make the production.

In light of Applicant's improperly ambiguous responses and the quality of Applicant's document production, Opposer cannot now fully evaluate these responses and reserves the right to object to these responses once they are supplemented and/or additional documents produced.

- No. 3: Please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine.
- No. 6: Applicant promised to produce documents sufficient to show Applicant's BIGG WHEELS products and any materials that may be included with such products. The latter documents were not produced. Please produce same. Additionally, the pictures are not legible enough to show "writings or marks thereon." Please produce legible photographs.
- No. 7: Applicant has only produced one magazine advertisement and one banner. This is insufficient; and Applicant should produce all of the requested documents.

Jacobson Holman PLLC

Donald L. Otto, Esquire

September 26, 2005

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No. 9: Applicant has only produced one magazine advertisement, Internet prints out for two websites and one banner. This is insufficient; and Applicant should produce all of the requested documents.

No. 10: Despite Applicant's promise to produce exemplary documents responsive to this request, Applicant has not produced any such documents.

No. 11: See comments regarding no. 6.

No. 12: This response is insufficient.

No. 14: Applicant's response is limited to Applicant's knowledge of "Opposer's Mark." However, the request is not so limited, and includes "Opposer."

Additionally, please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine.

Nos. 29-34: Applicant has refused to respond to these requests or produce responsive documents on the basis of attorney-client privilege and/or attorney work product doctrine. At a minimum, any non-privileged documents should be produced immediately. We refer to our demand for a privilege log, above.

In order to test the very broad application of privilege asserted by Applicant, we request that you immediately identify any withheld documents.

Nos. 35-37: Please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine.

Nos. 36/7: Applicant has produced one document responsive to this request – an August 2002 invoice. Please advise whether there are other documents responsive to this request and produce them.

Nos. 38-40: We note Applicant's confidentiality and relevance objections to these requests. As to the latter, the requests are clearly relevant. Please confirm that Applicant will provide the requested documents once a Protective Order is entered.

Nos. 45/46: Despite Applicant's promise to "produce any non-privileged documents responsive to" the requests, it appears that no documents have been produced. Please state whether any responsive documents exist and whether they have been withheld on grounds of privilege. As you likely know, search reports are not privileged.

Jacobson Holman PLLC

Donald L. Otto, Esquire

September 26, 2005

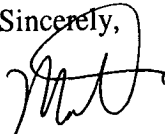
Page 7

- No. 47: Please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine.
- No. 58: Applicant has refused to produce any documents in response to this request, which seeks documents that support Applicant's denials of Opposer's admission requests. Please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine. In the meantime, Applicant should produce non-privileged documents. However, if Applicant is not producing any documents on the ground that the request is so "vague, ambiguous, over-broad and[/or] unduly burdensome" that no response may be made or document produced, please explain to us the basis for this assertion
- No. 59: Please explain why no response is made or document produced in response to this request.
- No. 61. No documents have been produced to date.
- No. 62. No documents have been produced to date.
- No. 69. This request seeks documents which show each state in which Applicant's products have been sold under Applicant's mark. Applicant's answer that it *intends* to sell its products "throughout the United States" is not responsive. Please respond to the request *as stated* and produce responsive documents.
- Nos. 70-87: Please confirm that Applicant will provide the requested documents once a Protective Order is entered.

We look forward to Applicant's supplemental responses, document production and/or your comments.

In the meantime, we suggest that an extension request be filed to allow the parties time to resolve these issues, including the negotiation, execution, and entering of a Protective Order. Please call me to discuss.

Sincerely,



Matthew J. Cuccias

G
GI

Tel. conf. Matthew Cuccini -
9/29/05

The Big Wheels Matter -

- 1) He to ~~submit~~ file a consented
order to extend all discovery &
testimony periods an additional 60 days
- 2) He to send me a the bel's
suggested Protective Order for then
will get into with any changes he
thinks might be appropriate -
- 3) When he does the rule also
let me know what they
will be saying about then / all
kind of repetition the way said
they would produce -
- 4) I told him I had many of
the same issues with respect to
their responses to our discovery
requests - in fact virtually none of
the information we requested was
provided - also if they are going
to require a privilege log, we
are going to require that to provide
one as well. Matthew said they

Were only requesting the log for
a few of the discovery requests,
but they can provide a
log as well if we are going to
request it -

Tel conf. Matthew Cuccias -
9/29/05

Re: Bigg Wheels Matter –

- 1) He to file a consented motion to extend all discovery & testimony periods an additional 60 days
- 2) He to send me a the Bd's suggested Protective Order from their web site with any changes he thinks might be appropriate –
- 3) When he does he will also let me know when they will be sending me their 1st round of production that they said they would produce –
- 4) I told him I had many of the same issues with respect to their responses to our discovery requests – in fact virtually none of the information we requested was provided – also if they are going to require a privilege log, we are going to require them to provide one as well. Matthew said they were only requesting the log for a few of the discovery requests, but they can provide a log as well if we are going to require it –



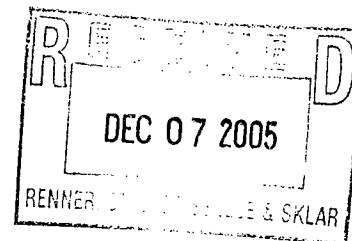
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December 5, 2005

Donald L. Otto, Esquire
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Cleveland, Ohio 44115-2191

Re: Opposition No. 163,791
Big O Tires, Inc. vs. Wheel Specialties, Ltd.
BIGG WHEELS – Serial No. 78/264,260
Our Reference: 11386/I-5156



Dear Mr. Otto:

In order to address the confidentiality issues, we enclose a draft Protective Order based on the Trademark Trial and Appeal Board's Standard Protective Order. If this is acceptable to your client, please have it executed and forwarded to us for execution and filing with the Board.

Further to our September 26, 2005 correspondence regarding various discovery disputes, we continue to await the receipt of Applicant's supplemental discovery responses and/or substantive comments relating to our September 26, 2005 correspondence.

Cordially,

Matthew J. Cuccias

MGG/MJC
Enclosure



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January 12, 2006

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Re: Opposition No. 163,791
Big O Tires, Inc. vs. Wheel Specialties, Ltd.
BIGG WHEELS - Serial No. 78/264,260
Your Ref: 11386/I-5156
Our Ref: WHEL.L0101

Dear Matthew:

The TTAB's standard Protective Order that accompanied your December 5, 2005 letter is acceptable. However, the form of certification referred to in section 4 of the Order as being attached was not included with your letter. Accordingly, please attach a copy to the enclosed signed Order before you sign and file it with the Board. Also please send me a fully executed copy of the Order with the form of certificate attached.

I will get back to you shortly regarding the various discovery disputes that you raised with respect to applicant's discovery responses as well as those I told you we also have with respect to opposer's discovery responses. Also this is a reminder that you have yet to send us the documents that opposer agreed to produce in its discovery responses. Please do so at this time.

Very truly yours,

Donald L. Otto

DLO:jm
enclosure
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BIG O TIRES, INC.,

Opposer,

vs.

WHEEL SPECIALTIES. LTD.,

Applicant.

Opposition No. 91163791

**PROVISIONS FOR PROTECTING
CONFIDENTIALITY OF INFORMATION
REVEALED DURING BOARD PROCEEDING**

Information disclosed by any party or non-party witness during this proceeding may be considered confidential, a trade secret, or commercially sensitive by a party or witness. To preserve the confidentiality of the information so disclosed, **either** the parties have agreed to be bound by the terms of this order, in its standard form or as modified by agreement, and by any additional provisions to which they may have agreed and attached to this order, or the Board has ordered that the parties be bound by the provisions within. As used in this order, the term "information" covers both oral testimony and documentary material.

Parties may use this standard form order as the entirety of their agreement or may use it as a template from which they may fashion a modified agreement. If the Board orders that the parties abide by the terms of this order, they may subsequently agree to modifications or additions, subject to Board approval.

Agreement of the parties is indicated by the signatures of the parties' attorneys and/or the parties themselves at the conclusion of the order. Imposition of the terms by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order. If the parties have signed the order, they may have created a contract. The terms are binding from the date the parties or their attorneys sign the order, in standard form or as modified or supplemented, or from the date of imposition by a Board attorney or judge.

TERMS OF ORDER

1) Classes of Protected Information.

The Rules of Practice in Trademark Cases provide that all inter partes proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this order are not to be used to undermine public access to files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing one of the following designations.

Confidential - Material to be shielded by the Board from public access.

Highly Confidential - Material to be shielded by the Board from public access and subject to agreed restrictions on access even as to the parties and/or their attorneys.

Trade Secret/Commercially Sensitive - Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent experts or consultants for the parties.

2) Information Not to Be Designated as Protected.

Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this document; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

3) Access to Protected Information.

The provisions of this order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected but are not required to sign forms acknowledging the terms and existence of this order. Court reporters, stenographers, video technicians or others who may be employed by the parties or their attorneys to perform services incidental to this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of paragraph 4.

- **Parties** are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.
- **Attorneys** for parties are defined as including **in-house counsel** and **outside counsel**, including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.
- **Independent experts or consultants** include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.
- **Non-party witnesses** include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

Parties and their attorneys shall have access to information designated as **confidential or highly confidential**, subject to any agreed exceptions.

Outside counsel, but not in-house counsel, shall have access to information designated as **trade secret/commercially sensitive**.

Independent experts or consultants, non-party witnesses, and any other individual not otherwise specifically covered by the terms of this order may be afforded access to **confidential or highly confidential** information in accordance with the terms that follow in paragraph 4. Further, **independent experts or consultants** may have access to **trade secret/commercially sensitive** information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraph 4 and 5.

4) **Disclosure to Any Individual.**

Prior to disclosure of protected information by any party or its attorney to any individual not already provided access to such information by the terms of this order, the individual shall be informed of the existence of this order and provided with a copy to read. The individual will then be required to certify in writing that the order has been read and understood and that the terms shall

be binding on the individual. No individual shall receive any protected information until the party or attorney proposing to disclose the information has received the signed certification from the individual. A form for such certification is attached to this order. The party or attorney receiving the completed form shall retain the original.

5) Disclosure to Independent Experts or Consultants.

In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed information with an independent expert or consultant must also notify the party which designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.

The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

6) Responses to Written Discovery.

Responses to interrogatories under Federal Rule 33 and requests for admissions under Federal Rule 36, and which the responding party reasonably believes to contain protected information shall be prominently stamped or marked with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

7) Production of Documents.

If a party responds to requests for production under Federal Rule 34 by making copies and forwarding the copies to the inquiring party, then the copies shall be prominently stamped or marked, as necessary, with the appropriate designation from paragraph 1. If the responding party makes documents available for inspection and copying by the inquiring party, all documents shall be considered protected during the course of inspection. After the inquiring party informs the responding party what documents are to be copied, the responding party will be responsible for prominently stamping or marking the copies with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

8) Depositions.

Protected documents produced during a discovery deposition, or offered into evidence during a testimony deposition shall be orally noted as such by the producing or offering party at the outset of any discussion of the document or information contained in the document. In addition, the documents must be prominently stamped or marked with the appropriate designation.

During discussion of any non-documentary protected information, the interested party shall make oral note of the protected nature of the information.

The transcript of any deposition and all exhibits or attachments shall be considered protected for 30 days following the date of service of the transcript by the party that took the deposition. During that 30-day period, either party may designate the portions of the transcript, and any specific exhibits or attachments, that are to be treated as protected, by electing the appropriate designation from paragraph 1. Appropriate stampings or markings should be made during this time. If no such designations are made, then the entire transcript and exhibits will be considered unprotected.

9) Filing Notices of Reliance.

When a party or its attorney files a notice of reliance during the party's testimony period, the party or attorney is bound to honor designations made by the adverse party or attorney, or non-party witness, who disclosed the information, so as to maintain the protected status of the information.

10) Briefs.

When filing briefs, memoranda, or declarations in support of a motion, or briefs at final hearing, the portions of these filings that discuss protected information, whether information of the filing party, or any adverse party, or any non-party witness, should be redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this order.

11) Handling of Protected Information.

Disclosure of information protected under the terms of this order is intended only to facilitate the prosecution or defense of this case. The recipient of any protected information disclosed in accordance with the terms of this order is obligated to maintain the confidentiality of the information and shall exercise reasonable care in handling, storing, using or disseminating the information.

12) Redaction; Filing Material With the Board.

When a party or attorney must file protected information with the Board, or a brief that discusses such information, the protected information or portion of the brief discussing the same should be redacted from the remainder. A rule of reasonableness should dictate how redaction is effected.

Redaction can entail merely covering a portion of a page of material when it is copied in anticipation of filing but can also entail the more extreme measure of simply filing the entire page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied would be appropriate. In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be effected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal. **Occasions when a whole document or brief must be submitted under seal should be very rare.**

Protected information, and pleadings, briefs or memoranda that reproduce, discuss or paraphrase such information, shall be filed with the Board under seal. The envelopes or containers shall be prominently stamped or marked with a legend in substantially the following form:

CONFIDENTIAL

This envelope contains documents or information that are subject to a protective order or agreement. The confidentiality of the material is to be maintained and the envelope is not to be opened, or the contents revealed to any individual, except by order of the Board.

13) Acceptance of Information; Inadvertent Disclosure.

Acceptance by a party or its attorney of information disclosed under designation as protected shall not constitute an admission that the information is, in fact, entitled to protection. Inadvertent disclosure of information which the disclosing party intended to designate as protected shall not constitute waiver of any right to claim the information as protected upon discovery of the error.

14) Challenges to Designations of Information as Protected.

If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time.

The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

15) Board's Jurisdiction; Handling of Materials After Termination.

The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

The parties may agree that archival copies of evidence and briefs may be retained, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, the parties and their attorneys shall return to each disclosing party the protected information disclosed during the proceeding, and shall include any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

16) Other Rights of the Parties and Attorneys.

This order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the order preclude the filing of any motion with the Board for relief from a particular provision of this order or for additional protections not provided by this order.

By Agreement of the Following, effective _____

[insert signature date]

BIG O TIRES, INC.

WHEEL SPECIALTIES, LTD.

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By order of the Board, effective _____.

[print or type name and title of Board attorney
or judge imposing order]

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Via Facsimile
202-393-5350
5 pages

Re: **Opposition No. 163,791**
Big O Tires, Inc. vs. Wheel Specialties, Ltd.
BIGG WHEELS - Serial No. 78/264,260
Your Ref: 11386/I-5156
Our Ref: WHEL.L0101

Dear Matthew:

As I advised you previously, many of Opposer's responses to Applicant's discovery requests are deficient for substantially the same reasons set forth in your September 26, 2005 letter concerning Applicant's responses to Opposer's discovery requests. In fact, very little of the information requested in Applicant's discovery requests was provided, and Opposer has yet to produce any of the requested documents.

We specifically call your attention to the following deficiencies in Opposer's responses to Applicant's interrogatories and document requests:

INTERROGATORIES

Number

2. Opposer agreed to produce a directory of Big O Stores but has yet to do so. Please produce.

Matthew J. Cuccias, Esq.
January 19, 2006
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4a and 4e. These responses are insufficient. Opposer did not identify which of Opposer's Marks is used on or in association with each product or service offered by Opposer as requested in 4a. Also Opposer did not give the inclusive dates during which Opposer has offered or sold each product or service under each of Opposer's Marks as requested in 4e. Please supplement.

4f. Opposer's agreement to produce documents from which Opposer's annual sales figures for a reasonable period may be derived or ascertained is not responsive to this interrogatory which requests the annual sales figures of each product or service identified in 4a from the date of first use of each of Opposer's Marks on or in association with each product or service. Please supplement.

6. This response is insufficient. In addition to providing a listing of all USPTO *inter partes* proceedings in which Opposer's Marks have been pleaded, please state the disposition or current status of each proceeding, and identify all documents relating thereto including particularly any settlements that may have been reached.

7. Opposer has objected to this interrogatory as seeking confidential and attorney-client privileged and/or attorney work product information and material of Opposer. Please provide sufficient identifying information for all documents responsive to this interrogatory.

12. Opposer's knowledge of any past or present third party uses or registrations of any names or marks including the term "BIG" or "BIGG" with respect to any goods or services marketed or sold in the automotive accessories, automotive repair services and automotive maintenance services is clearly relevant. To the extent that Opposer considers this information to be confidential, please provide such information under the agreed to protective order.

13. This response is inadequate. Applicant is entitled to know the factual basis for each of Opposer's allegations as stated in paragraphs 5-7 and 9-12 of Opposer's Notice of Opposition. Please supplement. Also please provide sufficient identifying information for all documents responsive to this interrogatory.

DOCUMENT REQUESTS

Number

1. This response is insufficient. In addition to providing representative samples of the current use of Opposer's Marks (which Opposer agreed to produce but has yet to do so), please produce documents sufficient to show Opposer's continuing use of each of Opposer's Marks at least since prior to Applicant's BIGG WHEELS trademark application filing date of June 18, 2003.
2. This response is too limited. Please produce all documents relating to any permission given by Opposer to any third party (not just franchisees of Opposer) to use a mark or trade name which Opposer considered or considers to be similar or identical to any of Opposer's Marks, including all documents permitting such use. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.
3. This response is too limited. Please produce all documents relating to any permission given by Opposer to any third party (not just franchisees of Opposer) to use a trademark, service mark or trade name constituting or including the term "BIG" or "BIGG", including all documents permitting such use. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.
4. Please produce all documents responsive to this request. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.
5. This request is clearly relevant. Please produce all documents responsive to this request. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.
6. Please produce all documents responsive to this request. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.

Matthew J. Cuccias, Esq.
January 19, 2006
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7. This response is insufficient. In addition to providing a listing of any action or proceeding in any court or other tribunal including but not limited to the USPTO filed by Opposer against a third party or filed by a third party against Opposer involving any of Opposer's Marks, please produce all documents relating to any settlements that may have been reached in any such action or proceeding. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.

8.-11, 13 and 24. No documents have been produced to date. Please produce the documents Opposer already agreed to produce.

15, 17, 23, 25-31, 33-35 and 40. No documents have been produced to date. Please produce the documents Opposer already agreed to produce. If Opposer withholds any documents responsive to any of these requests, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.

37. Please produce all documents responsive to this request. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.

38. This response is too limited. Please produce all documents relating to any third party uses (not just franchisees of Opposer) of any trademark, service mark or trade name incorporating "BIG" or "BIGG" alone or in combination with other words, letters or symbols. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.

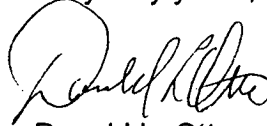
39 and 41. These requests are clearly relevant. Please produce all documents responsive to these requests. If Opposer withholds any documents responsive to these requests, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.

42 and 43. Please produce all documents responsive to these requests. If Opposer withholds any documents responsive to these requests, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.

Matthew J. Cuccias, Esq.
January 19, 2006
Page 5

I look forward to receiving Opposer's supplemental responses and document production. However, before either party responds to the other's additional requests, I suggest we try to reach an agreement as to the extent to which the parties need supplement their responses so it isn't one sided. Also I suggest that you file a further sixty day extension request to give us time to resolve these issues. Please let me know if you concur with that.

Very truly yours,

A handwritten signature in black ink, appearing to read "Donald L. Otto", written in a cursive style.

Donald L. Otto

DLO:jm

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